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JUN 03 1999

Group 2700

June 1, 1999

Fax Number:

To:

Examiner Ahmad Matar

Art Unit 2700

Telephone:

(703) 305-4731

~~(703) 308-5357~~

305-7201

~~(703) 308-6916~~

From: Steven R. Sprinkle  
512-457-7025 457-7025

Client-Matter Number: 103739.991101

Re: Petition to Make Special

Pages: - 20 - (including this form)

If there is a problem with this transmission, please call (512) 457-7000  
Fax Operator/Ext.

**Message:**

Examiner Ahmad Matar:

Please find attached to this facsimile transmission a Petition to Make Special Because of Actual Infringement Pursuant to 37 C.F.R. § 1.102. I would very much appreciate your attention to this matter at your earliest convenience. Please let me know if I can provide you with additional information. Thank you for your time and consideration.

Steve Sprinkle

*Duplicate***CONFIDENTIALITY NOTICE**

This communication is ONLY for the person named above. Unless otherwise indicated, it contains information that is confidential, privileged or exempt from disclosure under applicable law. If you are not the person named above, or responsible for delivering it to that person, be aware that disclosure, copying, distribution or use of this communication is strictly PROHIBITED. If you have received it in error, or are uncertain as to its proper handling, please immediately notify us by collect telephone and mail the original to us at the above address. Thank you.

(Form Rev. 7/26/96)

OFFICIAL

09/060,867

Attorney Docket No.: ACUI-1100-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE FAX RECEIVED

JUN 03 1999

Group 2700

Applicant: Andrew T. Busey, et al.  
Serial No.: 09/060,867  
Filing Date: April 15, 1998  
Group Art Unit: 2700  
Examiner: Ahmad Matar  
Title: METHOD AND APPARATUS FOR REAL TIME  
NETWORK COMMUNICATION

**VIA FACSIMILE**

Assistant Commissioner  
of Patents  
Washington, D.C. 20231

## CERTIFICATION UNDER 37 CFR § 1.6(d)

I hereby certify that the documents referred to as attached herein are being transmitted to the The Assistant Commissioner of Patents via facsimile, on this date, June 1, 1999, directed to the facsimile number (703) 308-5357, addressed to Examiner Ahmad Matar in Group Art Unit 2700.

Janice DiPetta 6/1/99  
Janice DiPetta Date

**PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT**  
**PURSUANT TO 37 C.F.R. § 1.102**

Sir:

Applicants submit this Petition to the Commissioner under 37 C.F.R. § 1.102 to make special and advance the examination of the above-identified application because of actual infringement.

This petition is accompanied by: (1) an Information Disclosure Statement; and (2) a Declaration by Edward C. Horvath in Support of Petition to Make Special Because of Actual Infringement.

Applicants hereby file this petition to make special and request that this petition be granted and that the application be allowed.

Authorization is hereby given to deduct the fee for filing this petition to make special because of actual infringement of \$130.00 from Deposit Account No. 50-0456, as set forth in 37 C.F.R. § 1.17(i). While no other fees are believed due, authorization is also given to charge any additional fees in connection with this petition to Deposit Account No. 50-0456.

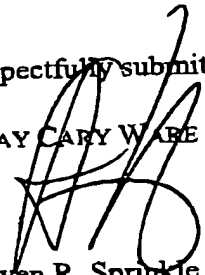
09/060,867

Attorney Docket No. ACUI-1100-1  
Page 2

In the event matters remain to be resolved in view of this communication, the Examiner is invited to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

GRAY CARY WARE ▲ FREIDENRICH LLP

  
Steven R. Sprinkle  
Registration No. 40,825

Date: June 1, 1999

100 Congress Avenue, Suite 1440  
Austin, Texas 78701  
Telephone: (512) 457-7025  
Facsimile: (512) 457-7070

09/060,867  
Attorney Docket No.: ACUI-1100-1FAX RECEIVED  
JUN 03 1999  
Group 2700

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Andrew T. Busey, et al.  
Serial No.: 09/060,867  
Filing Date: April 15, 1998  
Title: METHOD AND APPARATUS FOR REAL TIME  
NETWORK COMMUNICATION

Assistant Commissioner of Patents  
Washington, D.C. 20231

**CERTIFICATION UNDER 37 CFR §1.10**

I hereby certify that the documents listed below are being deposited with the United States Postal Service as "Express Mail" in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on May 3, 1999.

  
Rebecca J. Morrison

**DECLARATION BY EDWARD C. HORVATH IN SUPPORT OF  
PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT**

I, Edward C. "Ned" Horvath, Chief Technical Officer for Acuity Corporation (assignee of the above-referenced application) do hereby make the following declarations:

1. The present application is a continuation application filed April 15, 1999 as a continuation of parent application serial number 08/722,898, now issued as U.S. Patent Number 5,764,916 (the "916 Patent").
2. On or about January 1997, named inventor Andrew Busey, at the time an employee of the assignee ichat, inc. ("ichat"), initially became aware that eShare Technologies ("eShare") had developed a chat-based product accessible through the eShare web site that might infringe the claims of this and other applications filed by ichat.

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3. On or about May 1998, in my role as ichat's Chief Technology Officer, I became aware that Yahoo, America OnLine ("AOL") and Excite had each deployed a chat-based product accessible through these company's respective web sites that might infringe the claims of this patent application.

4. On or about August 1998, assignee ichat changed its corporate name to Acuity Corporation ("Acuity").

5. On or about May 1, 1999, I completed a rigid comparison of the eShare, AOL, Yahoo and Excite products with the claims of the present application. Based on this comparison, it is my opinion that at least Claims 1-3 of this patent application are unquestionably infringed by the eShare, AOL, Yahoo and Excite products.

6. The eShare product was accessed by going to an eShare customer at the web site [www.lockon.com](http://www.lockon.com) (see attached Exhibit A).

7. The Yahoo product can be accessed at web site [www.yahoo.com](http://www.yahoo.com) (see attached Exhibits B-G).

8. The AOL product can be accessed at web site [www.aol.com](http://www.aol.com) (see attached Exhibits H and I).

9. The Excite product can be accessed at web site [www.excite.com](http://www.excite.com) (see attached Exhibits J and K).

10. I have a good knowledge of the pertinent prior art. The prior art made of record in the parent '916 patent, and therefore of record in this continuation application, along with the art contained in the accompanying Supplemental Information Disclosure Statement represent the pertinent prior art.

11. I believe that all of the claims in this application are allowable over the prior art.

12. All statements made herein of my own knowledge and are true and all statements made on information and belief are believed to be true; these statements were made

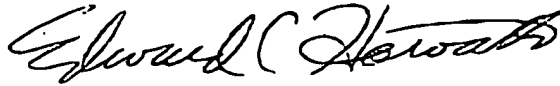
ATTORNEY DOCKET NO.:  
ACUI-1100-1

09/060,867

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with the knowledge that willful false statements and the like so made are punishable by fine, imprisonment or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Respectfully submitted,

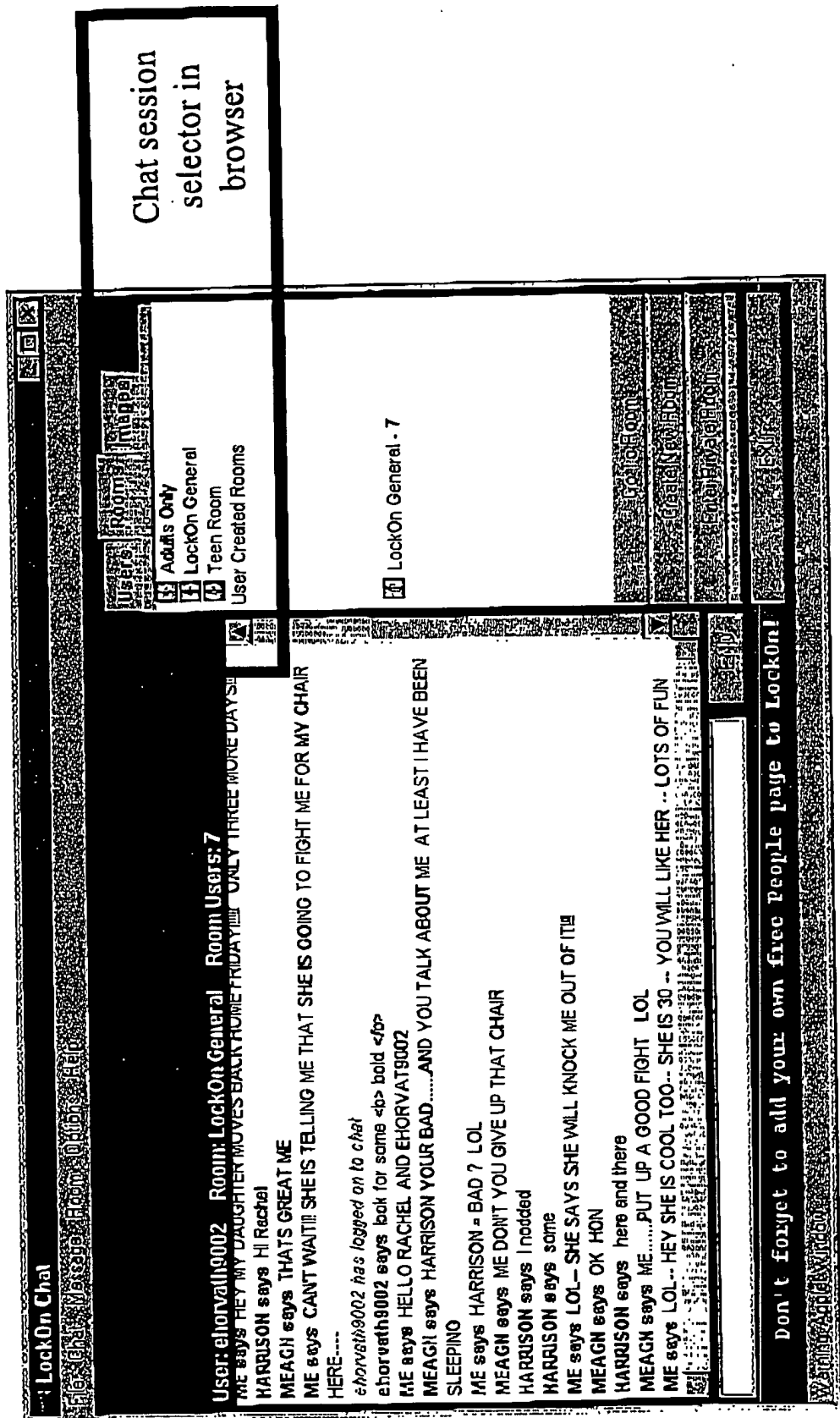


Edward C. Horvath  
Chief Technical Officer, Acuity Corporation

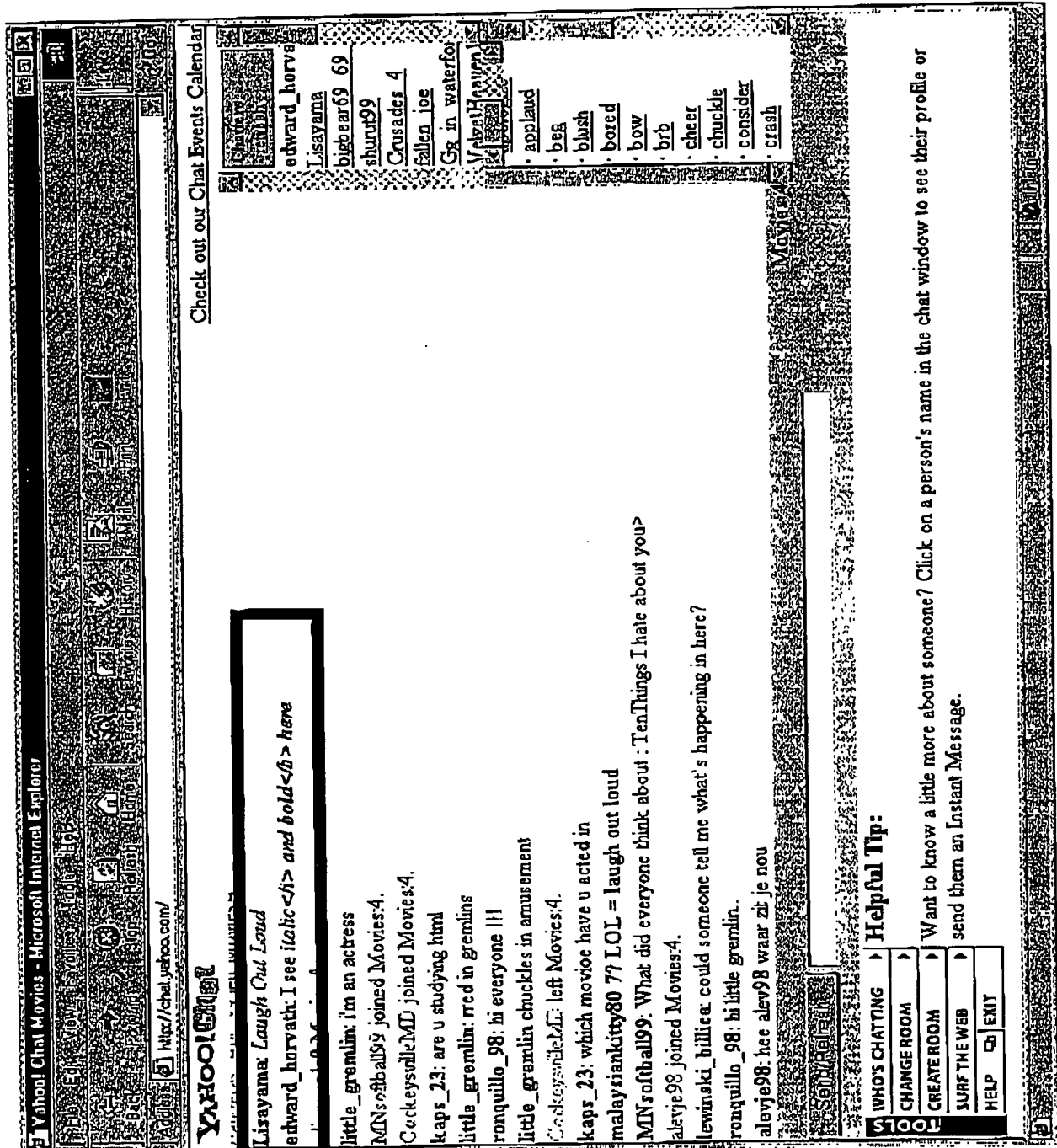
Date: May 3, 1999

# Exhibit A

## eShare (lockon.com) chat in browser



# Yahoo - Markup Language (ML)





## Exhibit C

## Yahoo - java (plugin) before send

Yahoo! Chat Movies - Microsoft Internet Explorer

http://chat.yahoo.com/

You are in **Modus4** (Seen any good movies lately? Visit <http://movies.yahoo.com/>)

**Logging** **edward\_hornvath** into the chat system...

\*\*\* Nobody in your friend list is currently online.  
You can [Edit your Friend List](#), or [Get Yahoo! Pager](#) here.

Welcome To Yahoo! Chat, **edward\_hornvath**  
You are in **Modus4** (Seen any good movies lately? Visit <http://movies.yahoo.com/>)

**lewiniskl\_billica** : wherefrom are you,ronquillo  
**kaps\_23** : howwazzal  
**ronquillo\_98** : are you still there kaps  
**Lisayama** : no, but some one told me it was really good, so i rented it  
**malaysiankitty00** guys - AGESEXLOCATION CHECK  
**ronquillo\_98** : I am from the Philippines  
**Swinn\_1000** left the room.  
**The\_Ryoga\_Hibiki** joined the room.  
**kaps\_23** : yes inf course and waiting for u to reply  
**edward\_hornvath** : This permits bold and italic too  
**The\_Ryoga\_Hibiki** left the room.  
**ronquillo\_98** : how 'bout you Lewinsk  
**Yodaddiphin** joined the room.  
**lewiniskl\_billica** : is it hot there?  
**Cara\_The\_Less** : still in the room  
**bbayons** joined the room.  
**Lisayama** : ten out of ten  
**ronquillo\_98** : not really

**Available** 16

Note the ML in this line (bolded stuff c/o and italicized c/b and c/b both/bx c/f)

Want to know a little more about someone? Click on a person's name in the chat window to see their profile or send them an Instant Message.

CHANGE ROOM  
CREATE ROOM  
SURF THE WEB  
HELP  
EXIT

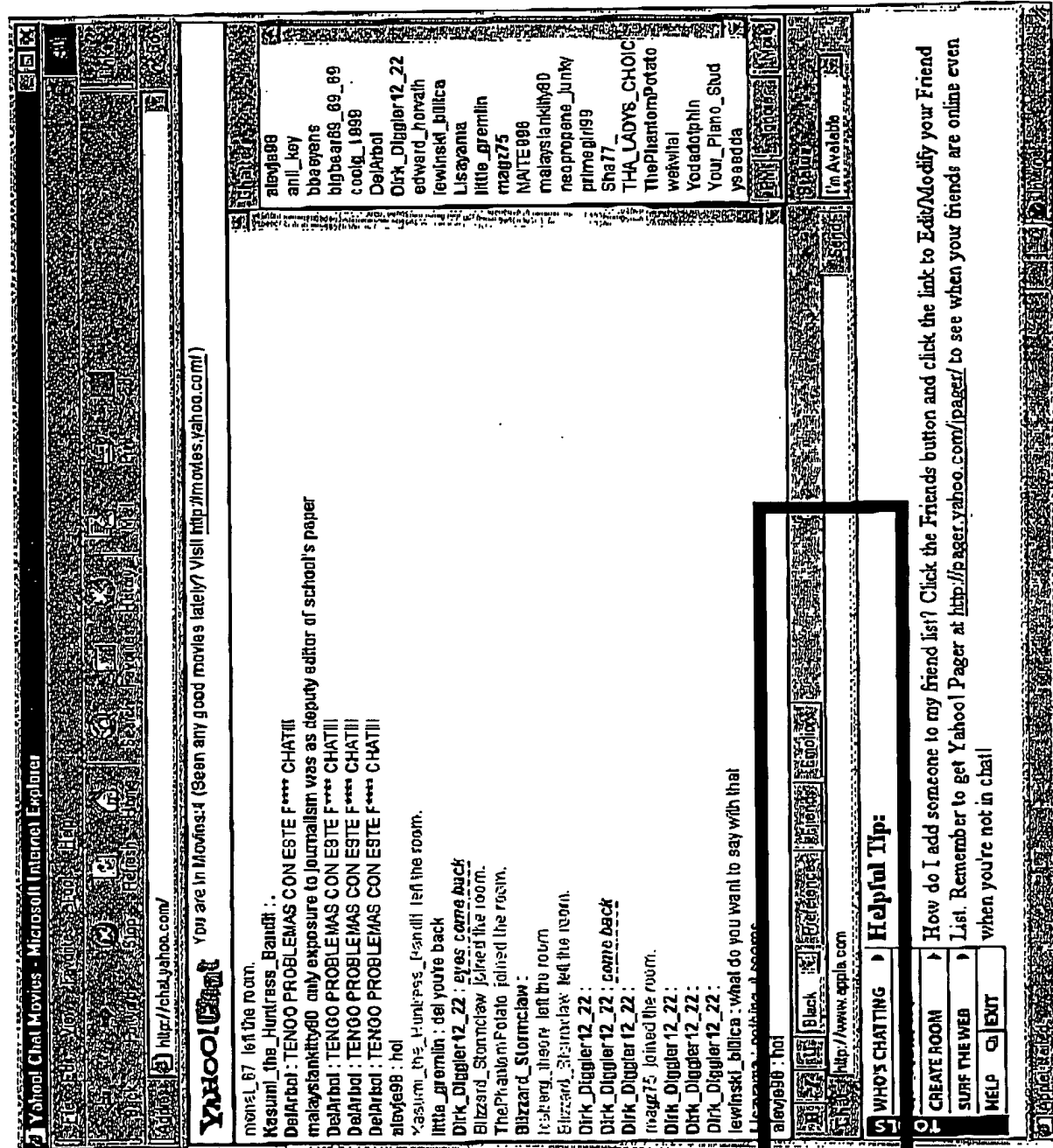
aleve98  
ant\_key  
bigbear69\_69\_69  
coolg\_1989  
OelAbol  
edward\_hornvath  
fallen\_joe  
Fast\_huey  
kaps\_23  
lewiniskl\_billica  
Lisayama  
little\_gremih  
malaysiankitty00  
MNsoftball99  
monet\_67  
neopropene\_junky  
prima gl/198  
ronquillo\_98  
THA\_LADYS\_CHOIC  
VelvetHeaven1  
velvetlal  
Yodaddiphin

# Exhibit D

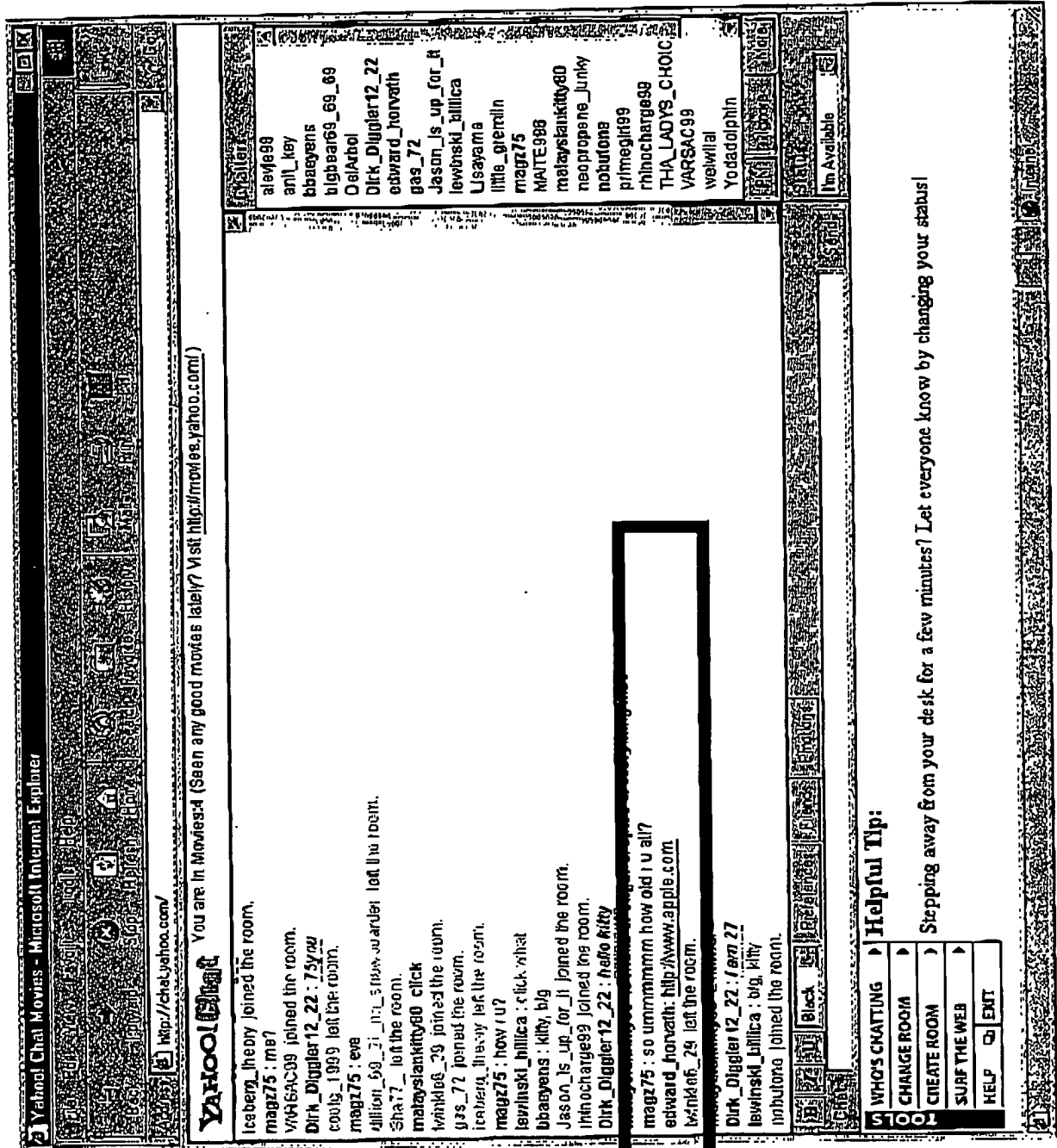
# Yahoo - after send

[illegible]

# Yahoo - URL - before send

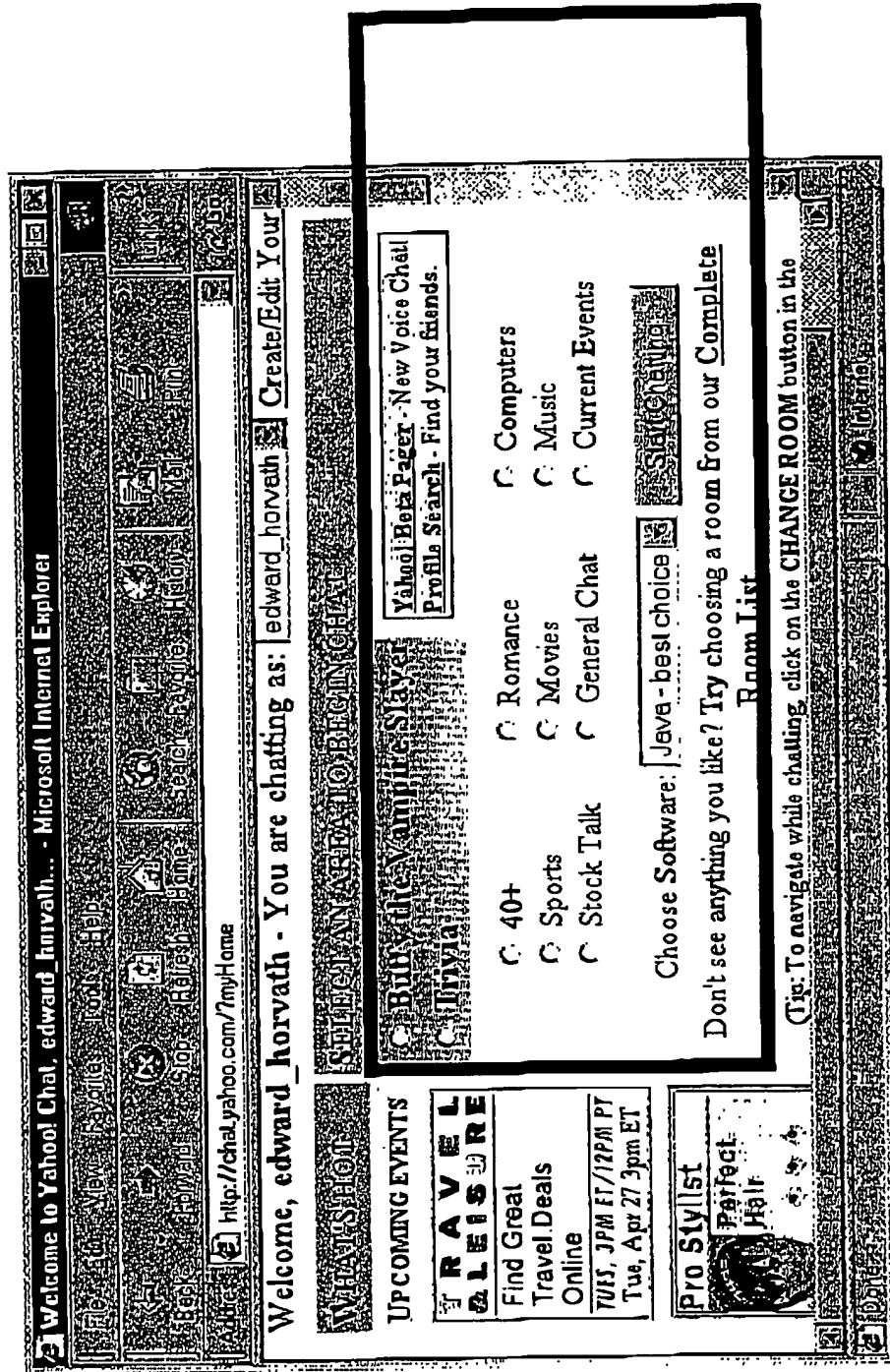


# Yahoo - URL - after



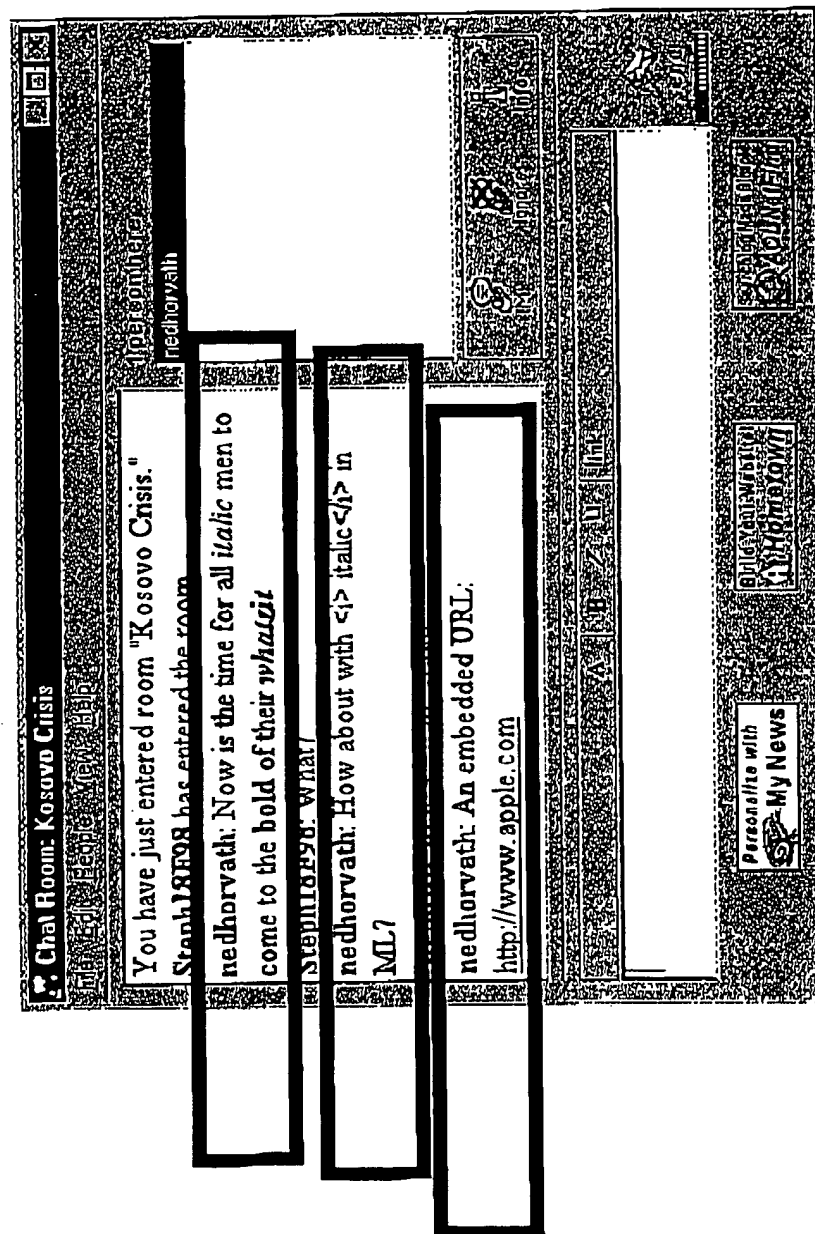
## Exhibit G

## Yahoo - browser doc selects chat



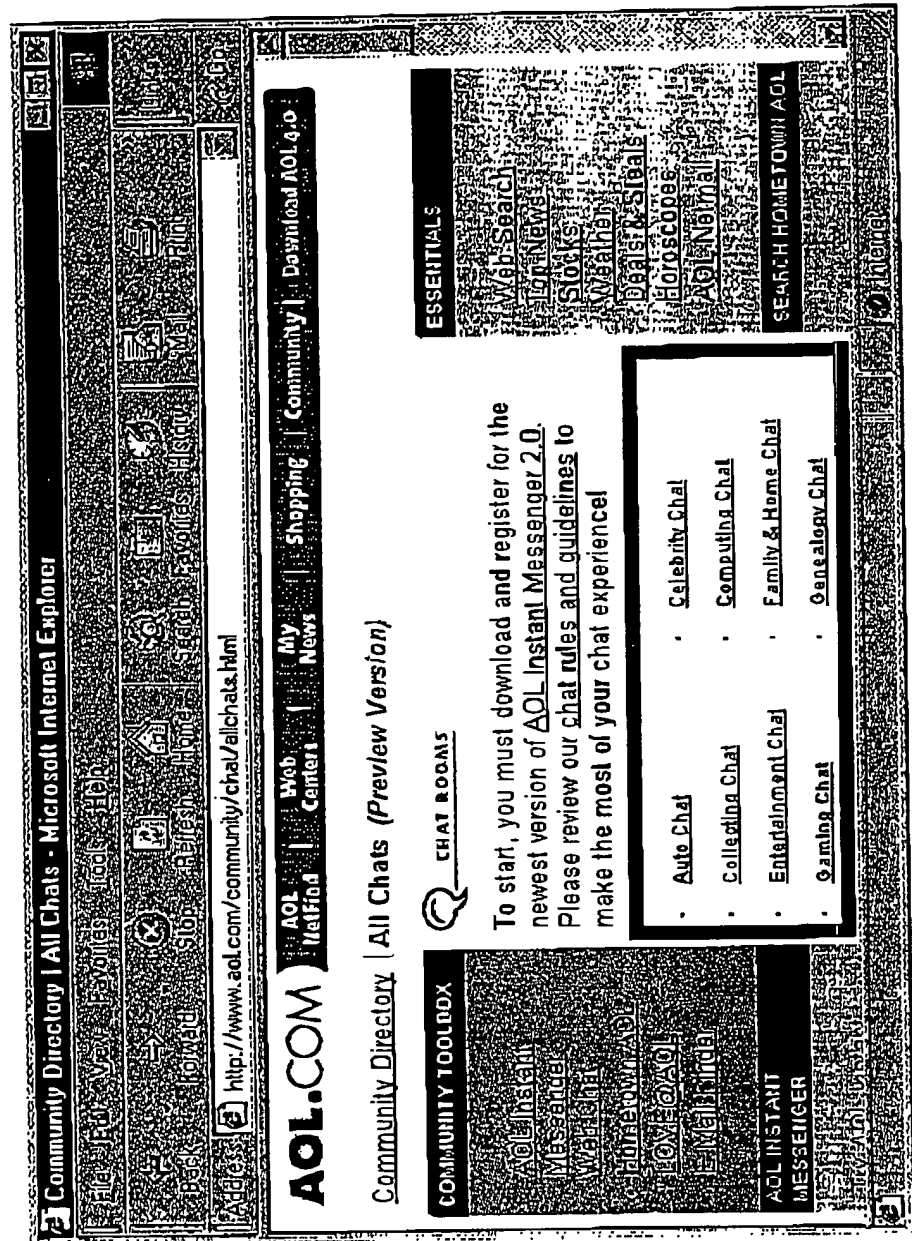
## Exhibit H

## AOL Chat



# Exhibit I

# AOL - browser doc selects chat



## Exhibit J

## Excite - browser doc selects chat

Excite Chat Sign-in - Microsoft Internet Explorer

File Edit View Favorites Tools Help

**excite**  
COMMUNITIES

**Join one now!** Your email:

**or Start your own!**

[Click Here!](#)

**chat**  
by **excite**  
and **WEBDAVE**

[Members login here](#)

[Community Standards](#)

**Step 1: Choose a nickname:**

**Step 2: Select a chat room!**

Peers	<input type="checkbox"/>
Interests	<input type="checkbox"/>
Regions	<input type="checkbox"/>
General Chat	<input type="checkbox"/>
Special Events	<input type="checkbox"/>
Sports	<input type="checkbox"/>
Adults Only	<input type="checkbox"/>

We give all of our loyal users their own name.  
Click here to become an [Excite member for free](#)

Do you want to use word filtering?

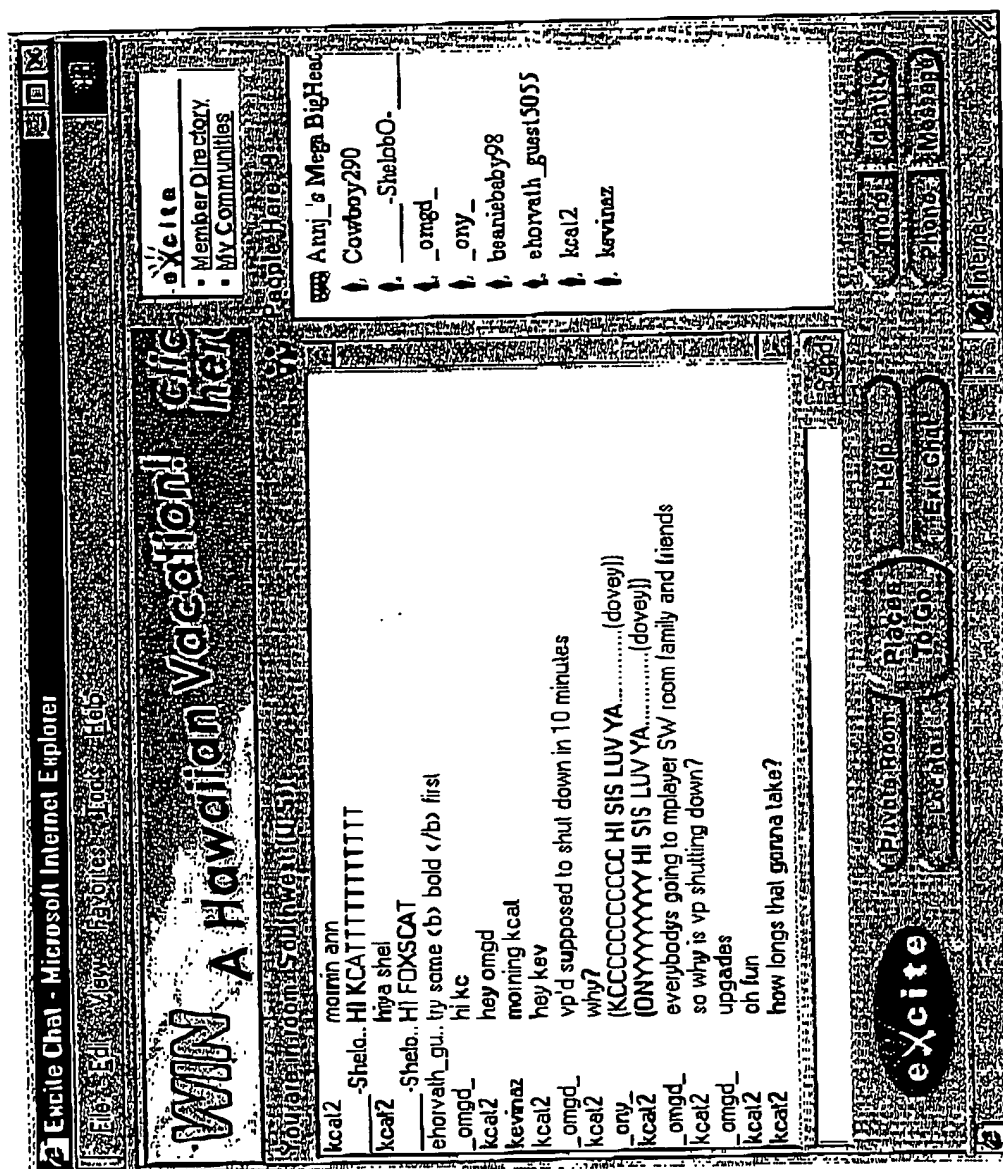
☒ No ☐ Yes

[Click Here!](#)



## Exhibit K

# Excite chat in browser



09/060,867

Attorney Docket No.: ACUI-1100-1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Andrew T. Busey, et al.  
Serial No.: 09/060,867  
Filing Date: April 15, 1998  
Group Art Unit: unknown  
Examiner: unknown  
Title: METHOD AND APPARATUS FOR REAL TIME  
NETWORK COMMUNICATION

Assistant Commissioner  
of Patents  
Washington, D.C. 20231

## CERTIFICATION UNDER 37 CFR § 1.0

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as "Express Mail" on this date, May 3, 1999, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231

*Rebecca J. Morrison* 5-3 99  
Rebecca J. Morrison Date

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 C.F.R. §§ 1.56, 1.97 and 1.98, applicant respectfully requests that the references listed on the attached PTO-1449 form be considered and cited in the examination of the above-identified application. A copy the cited references are enclosed for the convenience of the Examiner. Furthermore, pursuant to 37 C.F.R. §§ 1.97(g) and (h), no representation is made that a search has been made or that this art is material to patentability of the present application.

There are no fees due in connection with the filing of these documents. However, should the Examiner deem any fees necessary, the undersigned hereby authorizes the deduction of said fees from Deposit Account No. 50-0456 of Gray, Cary, Ware & Freidenrich.

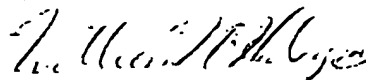
Attorney Docket No. ACUI-1100-1  
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Applicant respectfully submits that the claims of Applicant's above-referenced patent application are patentably distinguishable from these references.

Respectfully submitted,

GRAY CARY WARE ▲ FREIDENRICH LLP



William N. Hulsey III  
Registration No. 33,402

Date: May 3, 1999

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Facsimile: (512) 457-7070

FORM PTO 1449 US Department of Commerce Patent and Trademark Office	ATTY DOCKET NO.: ACUI-1100-1	SERIAL NO.: 09/060,867
	APPLICANT(S): Andrew T. Busey, et al.	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT	FILING DATE: April 15, 1998	GROUP ART UNIT: unknown

## U.S. PATENT DOCUMENTS

EXAM. INITIALS		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	A1	5,659,729	8-19-97	Nielsen	395	603	2-1-96
	A2	5,671,428	9-23-97	Muranaga, et al.	395	772	8-28-92
	A3	5,220,657	6-15-93	Bly, et al.	395	425	4-15-91
	A4	5,159,669	10-27-92	Trigg, et al.	395	159	12-15-88
	A5	5,796,393	8-18-98	MacNaughton, et al.	345	329	11-8-96
	A6	5,828,839	10-27-98	Moncreiff	395	200	11-14-96
	A7	5,862,330	1-19-99	Anupam, et al.	395	200	7-16-96
	A8						
	A9						

## FOREIGN PATENT DOCUMENTS

EXAM. INITIALS		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION (YES/NO)
	B1						
	B2						

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages)

	C1	
	C2	

EXAMINER	DATE CONSIDERED
----------	-----------------

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

